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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,268	03/16/2001	Jean-Louis H. Gueret	5725.0869-02	5334

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EXAMINER

ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 04/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,268

Applicant(s)

GUERET, JEAN-LOUIS H.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 136,137,146,148-152,156,161,163,174,175,179,189 and 190 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/807,276.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 23-135, 138-145, 147, 153-155, 157-160, 162, 164-173, 176-178, 180-188 and 191-222.

DETAILED ACTION

Election/Restrictions

Applicant's argument filed on January 22, 2003 with regard the "Election/Restriction" and the claims withdrawn from further consideration as being directed to nonelected Species has been considered but they are not persuasive because of the reasons set forth in the "Election/Restriction" section of the "Detail Action" mailed on October 22, 2002 (Paper No. 9). Furthermore, with regard applicant's argument that the "Summary of the Invention" provides a description to Species IV, it is noted that the "Summary of the Invention" provides a description of different options or features a species may have. It does not specifically describe the features of elected Species IV, i.e. Figure 4. That, it is found in page 8, line 27, through page 9, line 7. Moreover, if the species are not patentably distinct, applicant should have submitted evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case, so that the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. However, applicant appears to agree that the Species are patentably distinct from each other since he elected without traverse in paper no. 8. It is noted that, the election was made with traverse (see paper no. 8) and made Final in the "Detail Action" mailed on October 22, 2002 (Paper No. 9). Applicant may file a petition under 37 CFR 1.144 for review of the restriction requirement.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 136-151, 163, 189, and 190 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,913,318. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patent lies in the fact that the patent claims include more elements and is more specific. Thus, the invention of the application claims are in effect a "species" of the "generic" invention of the patented claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the application are anticipated by the claims of the patent, they are not patentably distinct from the claims of the patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 136, 137, 146, 148,-152, 156, 161, 163, 174, 175, 179, and 189, 190 rejected under 35 U.S.C. 102(b) as being anticipated by Bloch, et al. (Reference U.S. Pat. 3,179,108 on PTO-1449).

Bloch, et al. disclose an applicator comprising an elongated flexible support including in cross-section a first planar surface and a second planar surface (see Figure 3). The first and second planar surface facing away from one another. The applicator also includes an application portion at a first end of the flexible support 16 and a gripping portion at a second end of the flexible support opposite the first end (see Figure 1). The applicator includes a layer of a spongy flexible material on the first planar surface at the gripping portion the material has a greater flexibility than the flexibility of the support. The first and second planar surfaces are parallel to one another. The flexible support further comprises layer of spongy flexible material on both gripping portion and application portion first and second planar surface (see Figure 1). The layers of spongy flexible material appears to be thicker than support. Bloch, et al. disclose that the applicator can be used to apply cosmetics.

Applicant is reminded that an anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data System, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). Furthermore, it is well settled that the law of anticipation does not required that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal "read on" something disclosed in the reference, i.e. all limitation of the claims are found in the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to

expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. *Standard Havens Products Inc. v. Gencor Industries Inc.*, 953 F.2d 1360, 21 USPQ 2d. 1321 (Fed. Cir. 1991).

Response to Arguments

Applicant's arguments filed on January 22, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that Bloch, et al. do not disclose first and second planar surfaces, it is noted that Bloch, et al. Figure 3 shows a cross-section of the support along a longitudinal axis of the support and the cross-section has what can be considered upper and lower planar surfaces (see Attachment A).

In response to applicant's argument that Bloch, et al. do not disclose that the spongy material is thicker than the support, it is noted that Figure 3 shows the spongy material thicker than the support. Also, it is noted that all of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. In re Boe, 148 USPQ 507 (CCPA 1966); In re Smith, 32 CCPA 959, 148 F. d. 351, 65 USPQ 167; In re Nehrenberg, 47 CCPA 1159, 280 F.2d 161, 126 USPQ 383; and In re Watanable, 50 CCPA 1175, 315 F.2d 924, 137 USPQ 350.

In response to applicant's argument about a personal interview, it is noted that the examiner contacted applicant's representative, Mr. Jay A. Stelacone on May 15, 2003, and explained why the examiner has refused to a personal interview. Specifically, the examiner has refused to a personal interview because of past experienced in prosecuting applications for the

same inventor in which agreements reached were conditional upon being satisfactory to a principal attorney. Also base on MPEP 713.03.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

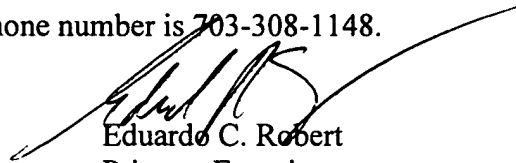
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



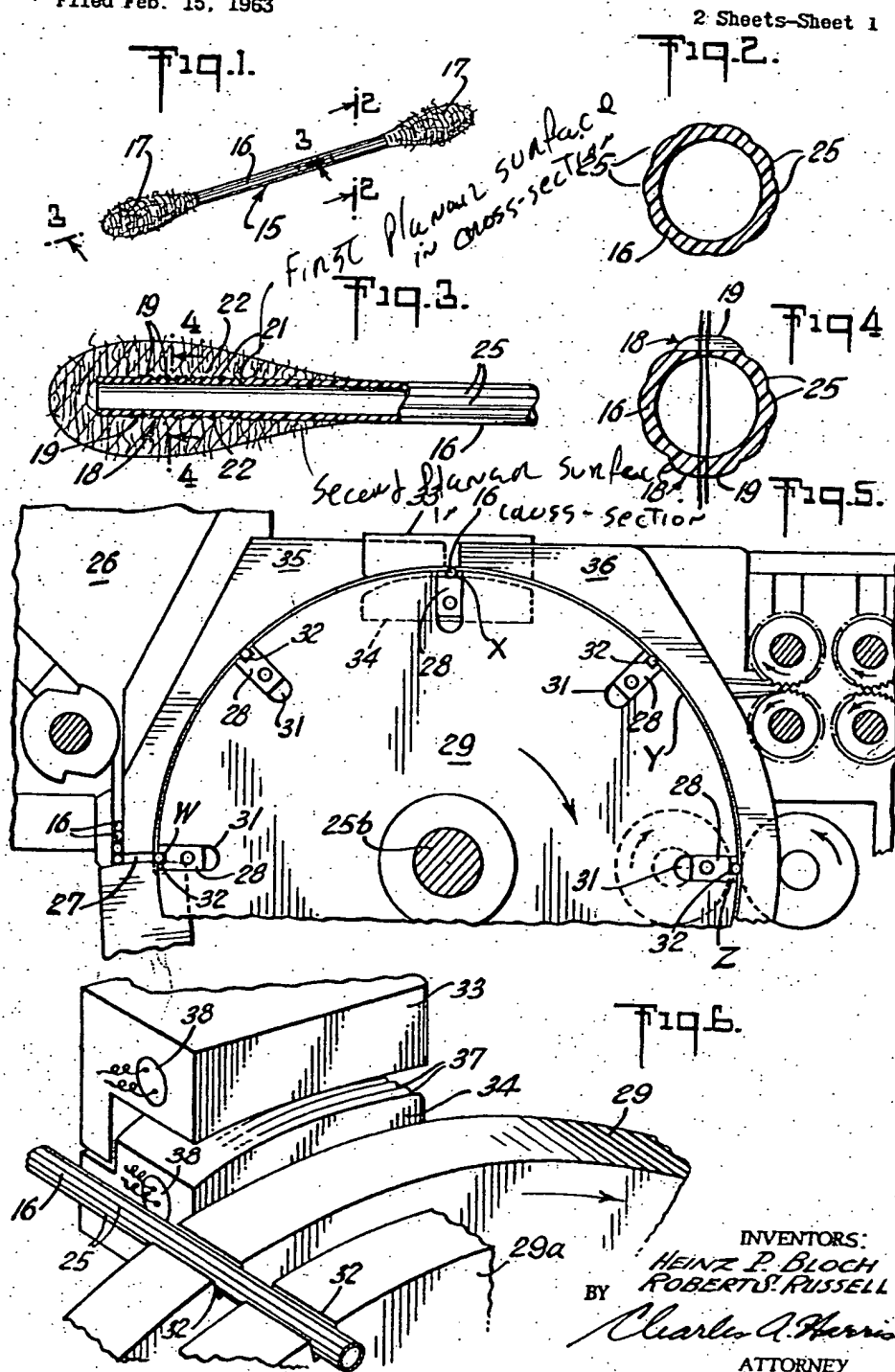
Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C. Robert
April 21, 2003

3,179,108

Filed Feb. 15, 1963

2: Sheets-Sheet 1



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